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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,681	03/09/2004	Karsten Hackbarth	H 5265	2641
423	7590	02/03/2010		
HENKEL CORPORATION One Henkel Way ROCKY HILL, CT 06067				
EXAMINER				
CHEUNG, WILLIAM K				
ART UNIT		PAPER NUMBER		
1796				
MAIL DATE		DELIVERY MODE		
02/03/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/796,681

Applicant(s)

HACKBARTH ET AL.

Examiner

WILLIAM K. CHEUNG

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 28, 31, 32 and 35-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28, 31, 32 and 35-41 is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The examiner acknowledges the receipt of the amendment and declaration filed December 9, 2009. Claims 7-27, 29-30, 33, 34 have been cancelled, and new claims 40, 41 have been added. Claims 1-6, 28, 31, 32, 35-41 are pending. The amendment filed December 9, 2009 for claims 1, 28, 36, and 39 is supported by original claims 1 and 7 filed March 9, 2004.
2. In view of the amendment filed December 9, 2009, the rejection of claims 1-3 and 5 under 35 U.S.C. 102(b) as being anticipated by Shustack (US Pat. 5,128,391), is withdrawn. The rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over Shustack (US Pat. 5,128,391) in view of Shustack (US Pat. 5,128,387), is withdrawn. The rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Shustack (US Pat. 5,128,391) in view of Razavi (US Pat. 5,629,365), is withdrawn. The rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Shustack (US Pat. 5,128,391) in view of Nagasawa et al. (US Pat. 4,205,018), is withdrawn. The rejection of claim 28, 31-39 under 35 U.S.C. 103(a) as being unpatentable over Shustack (US Pat. 5,128,391), is withdrawn. Further, the rejection of claims 28, 31-35, 37-39 are rejected under 35 U.S.C. 112, first paragraph, is withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 (line 17-19), the recitations of "wherein 2.0 to 9.7 wt. %, based upon total coating material, of the at least one low molecular weight (meth)acrylate is selected from difunctional, trifunctional and polyfunctional (meth)acrylate compounds" are considered "new matter" because the claimed subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants are required to file an amendment to remove the new matter introduced.

Applicant's arguments filed December 9, 2009 have been fully considered but they are not persuasive. Applicants argue that the claimed concentration is supported by Table of page 8 of the applicants' response filed August 8, 2007. However, applicants fail to recognize that the Table in page 8 does not disclose any (meth)acrylate compound; the table only disclose acrylate compounds. Therefore, the concentration teachings of acrylate compounds as taught in the Table does not adequately provide the support of the concentration of the (meth)acrylate compounds as claimed. Although applicants filed an affidavit December 9, 2009 to state that

(meth)acrylate generically also includes acrylate within its meanings. However, the examiner disagrees because (meth)acrylate and acrylate do not have identical molecular weights, and the same amounts would have different molar contents. Therefore, the teachings of (meth)acrylate is not transferable to acrylate. Even assuming that "(meth) acrylates" can represents "methacrylate" and "acrylates", applicants must recognize that the support of the concentration of a species does not support the concentration of its genus. The instant 112 rejection is maintained.

Allowances

5. Claims 28, 31, 32, 35-41 are allowed.
6. The following is an examiner's statement of reasons for allowance:

As of the date of this office action, the examiner has not located or identified any reference that can be used singularly or in combination with another reference including the closest prior art of Shustack (US Pat. 5,128,391), Shustack (US Pat. 5,128,387), Razavi (US Pat. 5,629,365), and Nagasawa et al. (US Pat. 4,205,018) to render the present invention anticipated or obvious to one of ordinary skill in the art. The prior art are silent on a composition comprising nanoparticulate aluminum oxide or hydrophobic silica that is present in highly dispersed form in the coating materials.

In light of the above discussion, it is evident as to why the present claims are patentable over the prior art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, and to avoid processing delays, should

preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/William K Cheung/
Primary Examiner, Art Unit 1796

William K. Cheung, Ph. D.
Primary Patent Examiner
January 26, 2010